

REMARKS

The enclosed is responsive to the Examiner's Office Action mailed on June 23, 2008. At the time the Examiner mailed the Office Action, claims 1-30 were pending. By way of the present response applicants have: 1) amended claims 1, 3-5, 7-17, 19, 21-24, and 27-30; and 2) added no claims; and 3) canceled claims 2, 6, 18, 20, 25, and 26. As such, claims 1, 3-5, 7-17, 19, 21-24, and 27-30 are now pending. No new matter has been added. Reconsideration of this application as amended is respectfully requested.

Claim Objections

The Examiner objected to claims 17 and 18 as being improper multiple dependent claims. Applicants have amended claim 17 to remove the multiple dependency. Applicants have canceled claim 18. Accordingly, applicants respectfully submit that this objection has been overcome.

The Examiner objected to claim 16 as being of improper dependent form. Applicants have amended claim 16 to be an independent claim. Accordingly, applicants respectfully submit that this objection has been overcome.

The Examiner objected to claims 1-30 for various informalities. Applicants have amended the claims and submit that these objections have been overcome.

Drawing Objections

The Examiner objected to the drawings for various informalities. Enclosed herewith are replacement sheets for Figures 1-3. Amended Figure 1 more clearly shows reference 13. Applicants have amended the specification to correct

descriptions of the biometric sensor as reference 5 rather than 7. Lastly, steps 4 and 5 for each of Figures 2 and 3 have been amended to be steps 4a and 5a and 4b and 5b respectively. Applicants have also amended the specification to reflect the changes from steps 4 and 5 to steps 4a and 5a and 4b and 5b.

Accordingly, applicants respectfully submit that these objections have been overcome.

Claim Rejections – 35 U.S.C. §112

Claims 16-18 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicants have amended claim 16 to be an independent claim and claim 17 to depend upon claim 16. Applicants have canceled claim 18. Accordingly, applicants respectfully submit that this rejection has been overcome.

Claim Rejections – 35 U.S.C. §102

Claims 1, 4-7, 9, 15-16, 19, 23-27 and 29 stand rejected under 35 U.S.C. §102(b) as being unpatentable over Brandys (WO 02/073877A2, hereinafter, “Brandys”).

Brandys describes a smart card that verifies biometric information and digitally signs messages upon authenticating a user. In particular, Brandys describes that the smart card signs a message by hashing the message to create a message digest, which is then encrypted with a private key to create a digital signature. A recipient of the message can verify the signature by using a public key.

Applicants have amended claim 1 to include features of original claim 2. As stated in the Office Action, Brandys does not disclose a portable data storage device arranged to generate at least one key and to encrypt the generated key using a secret key that is permanently stored in the portable storage device. (Office Action dated 6/23/08, page 10). Applicants will address rejections under 35 U.S.C. §103, as well as further differences between the claims and Brandys, below.

Accordingly, applicants respectfully submit that the rejection of claim 1 under 35 U.S.C. §102 has been overcome. Given that claims 4-7, 9, and 15 are dependent upon claim 1, and include additional features, applicants respectfully submit that the rejection of claims 4-7, 9, and 15 under 35 U.S.C. §102 has been overcome.

Regarding claim 16, similar to above, Brandys does not disclose a portable data storage device arranged to generate at least one key and to encrypt the generated key using a secret key that is permanently stored in the portable storage device. Accordingly, applicants respectfully submit that the rejection of claim 16 under 35 U.S.C. §102 has been overcome.

Regarding claim 19, similar to above, Brandys does not disclose a portable data storage device encrypting the generated key using the secret key permanently stored in the portable data storage device. Accordingly, applicants respectfully submit that the rejection of claim 19 under 35 U.S.C. §102 has been overcome.

Given that claims 23-27 and 29 are dependent upon claim 19, and include additional features, applicants respectfully submit that the rejection of claims 23-27 and 29 under 35 U.S.C. §102 has been overcome.

Claim Rejections – 35 U.S.C. §103

Claims 2-3, 8, 11-13, 20-22 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Brandys in view of Buch (U.S. Patent Pub No. 2003/0217165 hereinafter, “Buch”).

Buch describes user authentication of Session Initiation Protocol (SIP) messages using certificates. In particular, Buch describes an invite message containing a public key certificate to initiate a communication session in a computer network. The public key certificate is used to determine the identity of the sender and whether or not the communication request is accepted.

As stated above, applicants have incorporated the features of claim 2 into amended claim 1. Accordingly, claim 1 will be addressed here as well: Brandys and Buch fail to disclose a device that transmits data **requested** by a host. Furthermore, neither Brandys nor Buch, alone or in combination, discloses a portable data storage device arranged **to receive from the host** a digital signature **based on the generated key and the requested data** for use in verifying that the requested data has been correctly received by the host.

Brandys describes that the digital signature is created and **transmitted from the smart card** to an external device. In contrast, claim 1 states that the portable data storage device is arranged **to receive from the host** a digital signature **based on the generated key and the requested data**. In Brandys, the **external device uses the signature** and a public key to detect unauthorized changes to the message. In contrast, claim 1 states that **the portable data storage device uses the digital signature** in verifying that the requested data has been correctly received by the host.

Buch is primarily concerned with authenticating the identity of end users, not whether or not a message sent has been altered or correctly received. Furthermore, Buch describes that the caller merely receives a standard handshaking protocol (i.e., "OK message") from the callee when the callee successfully verifies the caller's identity. Therefore, Buch does not remedy the shortcomings of Brandys discussed above.

Accordingly, applicants respectfully submit that the rejection of claim 1 in view of Brandys and Buch has been overcome. Given that independent claims 16 and 19 contain features similar to claim 1 as discussed above, applicants respectfully submit that claims 16 and 19 are patentable over Brandys and Buch for at least the same reasons as above.

Given that claims 3-5, 7-15, 17, 21-24, and 27-30 are dependent claims with respect to claims 1, 16, and 19, and include additional features, applicants respectfully submit that claims 3-5, 7-15, 17, 21-24, and 27-30 are patentable over Brandys and Buch for at least the same reasons as above.

Claims 10 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brandys as applied to claims 1 and 19, and further in view of Iwagaki et al., (U.S. Patent Pub No. 2003/0161468 A1 hereinafter, "Iwagaki").

Claims 10 and 30 are dependent upon claims 1 and 19 respectively. Applicants respectfully submit that Iwagaki does not remedy the shortcomings of Brandys (and Buch) as discussed above. Accordingly, applicants respectfully submit that the rejection of claims 10 and 30 in view of Brandys and Iwagaki has been overcome.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Brandys as applied to claim 1, and further in view of Fang, (U.S. Patent 6,536,941 hereinafter, "Fang").

Claim 14 is dependent upon claim 1. Applicants respectfully submit that Fang does not remedy the shortcomings of Brandys (and Buch) as discussed above. Accordingly, applicants respectfully submit that the rejection of claim 14 in view of Brandys and Fang has been overcome.

CONCLUSION

Applicants respectfully submit that in view of the amendments and arguments set forth herein, the applicable objections and rejections have been overcome.

Applicants reserve all rights under the doctrine of equivalents.

Pursuant to 37 C.F.R. 1.136(a)(3), applicants hereby request and authorize the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 C.F.R. 1.16 and 1.17, to Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: October 22, 2008

_____/Ryan W. Elliott/

Ryan W. Elliott
Reg. No. 60,156

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
(408) 720-8300